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REMARKS

Summary of Amendments Made

No amendments to the claims have been made. Claims 2-12 are still pending.

35 U.S.C. 103 rejection

The lone issue for consideration is the rejection under 35 U.S.C. § 103(a) of claims 2-9 and 12 by the examiner over Patel et al. (U.S. Patent 5,385,783) in view of Sakumoto et al. (U.S. Patent 5,683,806) and Leeuwenburgh (U.S. Patent 5,935,669).

Clarification about a point on the difference between applicants' claimed invention and the prior art

While the applicants retain the positions held in their Appeal Brief (which is reproduced after this section), the applicants wish to further clarify a point which was raised in the Appeal Brief but may not have been immediately obvious to the reader, i.e. the references cited above do not teach that the masking paper is "adhered to and only partially covering said one side of said adhesive tape" and that the masking film is "adhered to and only partially covering the part of said one side of said adhesive tape". When considering these limitations together, the net result is that the masking paper is "wedged" underneath the masking film (while this is present in each of the applicants' Figure 1-3, this is most easily seen in Figure 2 - the masking paper is represented by 5; the masking film is represented by 6 and the adhesive is represented by 3).

The Leeuwenburgh reference was presumably relied upon for their teaching of the folded layer attached to the adhesive tape. However, Leeuwenburgh's folded layer, if being viewed as equivalent to the applicants' masking paper, is not covered by anything resembling the applicants masking film. If Leeuwenburgh's folded layer is being viewed as an equivalent to the applicants' masking film, then there is no masking paper which is "wedged" underneath the masking film, i.e. even if there was sufficient motivation or direction to use the teaching of Leeuwenburgh into the teaching of Patel and Sakumoto, this combination of references would still not teach all of the applicants' claim limitations.

Copy of arguments from Appeal Brief

Differences Between the Appellants' Invention and the Prior Art

The ultimate determination whether an invention would have been obvious under 35 U.S.C. § 103 is a legal conclusion based on underlying findings of fact (see *In re Kotzab*, 217 F.3d 1365,

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1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). After practicing the fact-based inquiry set forth by *Graham v. John Deere Co.*, the examiner determined that the Patel reference differed from the applicants' invention in at least four different ways (text below is from page 2, paragraph 4 of the examiner's Office Action dated 10 April 2002):

"Patel does not disclose a film. While Patel does not disclose a specific width or thickness for the adhesive tape, he does state that the tape can be prepared into predetermined widths and lengths. Patel does not disclose that the masking film is folded. Patel does not disclose a polyolefin film"

The examiner later acknowledged that even with the combination of Patel and Sakumoto "Neither reference teaches the masking film being folded or the masking film extending beyond said second edge of the masking paper." (see page 3, paragraph 6 of the Office Action dated 10 April 2002).

The appellants have further argued that the Patel reference has additional differences with the appellants' invention in that the appellants' invention requires that the contact adhesive is partially covered by masking paper (i.e. limitation b) in claim 12 and the remainder of the contact adhesive is covered by a masking film (i.e. limitation c) in claim 12. See simplified diagram of appellants' masking strip below:

Masking paper/Masking film
Contact adhesive layer
Paper support

Patel et al. does not teach or suggest the use of a masking paper/masking film on the contact adhesive layer. One of ordinary skill in the art would not be motivated to add this feature to the invention of Patel et al. because their adhesive layer 64 is protected by the release coat 60 as the tape is rolled up (see col. 2, lines 31-34).

When rolled, the release coat serves to protect both sides of the adhesive layer (see diagram of Patel's product below):

Interior of roll of tape
64 – adhesive layer #1
58 – impregnated paper #1
60 – release coat #1
64 – adhesive layer #2
58 – impregnated paper #2

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60 – release coat #2
64 – adhesive layer #3
58 – impregnated paper #3
60 – release coat #3

Exterior of roll of tape

No Reason or Motivation to Combine References in Order to Address the Differences

Acknowledged by the Examiner

The examiner previously stated that "Patel and Sakumoto are analogous art because they are from the same field of endeavor, that is masking tape....All references [including Leeuwenburgh] are analogous art because they are from the same field of adhesive tapes." (see page 3, paragraphs 6 and 7 of the examiner's Office Action dated 10 April 2002).

The appellants' respectfully disagree with the characterization of the Sakumoto reference as analogous art there it is unclear that this is a masking tape (i.e. there is no indication that this tape contains a masking paper as in the appellants' claimed invention); Sakumoto clearly states that their invention is directed toward an adhesive tape for electronic parts. Sakumoto discloses uses for compensating a shift of a lead pin in electronic parts, preventing a shorting of electronic parts and preventing a misalignment of wire bondings (see e.g. claims 6-9 of Sakumoto). However, even if *in arguendo* it was accepted that each of the references are "analogous" art, this would only establish that perhaps the references could be combined.

However, it has previously been held that "can be combined" is not the proper standard for establishing a *prima facie* case of obviousness. MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." see also *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, (Fed. Cir. 1990); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Neither the Patel or Sakumoto references teach or suggest making the appropriate modification to the teachings of Patel as described by the examiner ("...it is obvious to a person of ordinary skill in the art to combine the protective laminated adhesive layer of Sakumoto with the adhesive layer of Patel in order to provide protection for the adhesive layer of Patel so it would not lose its bonding properties.").

Even if proper to combine Patel with Sakumoto, the examiner acknowledged that "Neither

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reference teaches the masking film being folded or the masking film extending beyond said second edge of the masking paper." In order to address this difference, the Leeuwenburgh reference was additionally cited. However, Leeuwenburgh while teaching a folding pattern, does not establish a teaching or suggestion as to why this folding pattern should be applied to the invention of Patel in combination with Sakumoto.

Moreover, the examiner appears to be factually incorrect with the statement "Although Leeuwenburgh does not explicitly teach his cover sheet is a masking strip, it comprises the same materials and has the same function as the applicants claimed masking strip, absent any evidence to the contrary." It is unclear whether the examiner really meant to establish equivalence between the cover sheet and either the masking paper? or the masking film? rather than the entire masking strip of the appellants' invention which the cover sheet clearly is not.

Even if the references are relied upon for what they teach and suggest as a collective whole, it has previously been held that "*It is impermissible* within the framework of section 103 to *pick and choose* from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965))

More recently, it has been held that "...'Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.' see *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998). There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. see *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *ATD Corp.*, 159 F.3d 546, 48 USPQ2d 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1088, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ('When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.')" see *Crown Operations Int'l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

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If the examiner views the appellants' claimed self-adhesive masking strips as being "simple" technology, this still does not preclude providing a motivation to combine the references to arrive at the appellants' claimed invention nor does this lessen the standard for engaging in hindsight reconstruction. It was previously presented in *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, (Fed. Cir. 1999) that:

"...Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. **Close adherence to this methodology is especially important in the case of less technologically complex inventions**, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher.'...Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."

This would appear to be especially pertinent for the present situation where multiple differences have been acknowledged by the examiner.

Patel Generically Teaches Rolls of Tape of Predetermined Widths and Lengths Not the Relationship of Measurements of the Tape Components

One of the difference acknowledged by the examiner was explained away as follows: "While Patel does not disclose a specific width or thickness for the adhesive tape, he does state that the tape can be prepared into predetermined widths and lengths." However, the statement referred to by the examiner (see col. 3, lines 43-44 of Patel) refers to the entire roll of tape. This does not address the difference with respect to the relationship of the sizes of the contact adhesive, masking paper and masking film as recited in the appellants' claim 12.

Patel Reference Teaches Away From Accepting the Modifications Proposed by the Examiner

The examiner argues that it would be obvious to add a masking film to the invention of Patel. However, in addition to the lack of motivation for making such a modification, the Patel reference teaches away from the making this modification as it is clear that the tapes of Patel are intended to be rolled up into a core (see e.g. col. 3, lines 41-44). As such, there is no reason to insert the masking film/masking paper (both of which are in contact with the adhesive layer) between the release coat and adhesive layer of Patel or substitute a masking film/masking paper

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for the release coat as the release coat also serves to protect the adhesive layer.

While it is well known that a prior art reference can be used for what it teaches and not just the claimed invention, MPEP 2141.02 makes the contingency that "A prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention." (see MPEP 2141.02 and *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)). Even for the teaching pointed to by the examiner about the Patel reference (i.e. col. 1, lines 46-50), when this tape product is rolled up, the release coat and impregnated paper serve to protect the adhesive layer.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Preliminary Amendment (7 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 15 November 2004

By: Agata Ciriak
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